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PATENT APPLICATION

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**IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventor(s): Michele COVELL et al.

Confirmation No.: 2456

Application No.: 10/698,812

Examiner: Hieu T. Hoang

Filing Date: 10/30/2003

Group Art Unit: 2452

Title: SYSTEM FOR DOING SERVICE LOCATION MANAGEMENT TAKING INTO ACCOUNT THE NODE AND NETWORK CHARACTERISTICS

**Mail Stop Appeal Brief - Patents
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PO Box 1450
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TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on 10/16/2009 .

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

Respectfully submitted,
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant:	COVELL et al.	Patent Application
Application No.:	10/698,812	Group Art Unit: 2452
Filed:	October 30, 2003	Examiner: Hoang, Hieu T.
For:	SYSTEM FOR DOING SERVICE LOCATION MANAGEMENT TAKING INTO ACCOUNT THE NODE AND NETWORK CHARACTERISTICS	

REPLY BRIEF

In response to the Examiner's Answer mailed on October 16, 2009, Appellants respectfully submit the following remarks.

REMARKS

Appellants are submitting the following remarks in response to the Examiner's Answer. In these remarks, Appellants are addressing certain arguments presented in the Examiner's Answer. While only certain arguments are addressed in this Reply Brief, this should not be construed that Appellants agree with the other arguments presented in the Examiner's Answer.

Response to Response to Argument in Examiner's Answer

First, Appellants note that the Examiner's Answer asserts "[t]hat the service broker accesses a directory that includes a list of transcoders has nothing to do with the service broker receives or does not receive transcoders' information from other sources. On the contrary, the fact that there is a service directory including descriptions of the services (multimedia media transcoding services) would enable one skilled in the art to appreciate that the service information are provided to the service broker in some manner, in this case, from the service providers themselves (Pranata, 4.3.1 and 3.3.1, par. 3)" (Examiner's Answer; page 14, lines 8-14).

As presented in the Office Action, Appellants respectfully note that "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention" (emphasis in original; MPEP 2141.02(VI); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)).

Appellants respectfully submit that Pranata teaches away from the claimed embodiments. In particular, Pranata specifically recites that "[t]he purpose of the service broker is to find the

most appropriate transcoder for the client and then build service chain from the server to the client. It finds the transcoder using a directory which is stored in the lookup service” (emphasis added; 4.3.4).

Appellants respectfully submit that Pranata discloses that the service broker accesses a directory service that includes a list of transcoders. From this list, the service broker makes a selection. Moreover, Appellants respectfully submit that by disclosing that the information about transcoders is stored at the lookup service and that the selection of the transcoder is made at the service broker, Appellants respectfully maintain that Pranata teaches away from “receiving service provider information from a plurality of service providers at a service location manager, said service provider information comprising indications of initiation and termination of service sessions involving said plurality of service providers” and “maintaining data at said service location manager, said data comprising identification of said plurality of service providers, static service provider information and static network information, wherein said data is based at least in part on said service provider information” (emphasis added) as claimed.

Moreover, in asserting that the Appellants’ argument is “not logical” (Examiner’s Answer; page 14, lines 7-8), Appellants respectfully submit that the Examiner’s Answer fails to consider that Pranata includes “portions that would lead away from the claimed invention.”

Second, Appellants understand the Examiner’s Answer to assert that Pranata does not teach away from the claimed embodiments. In supporting this assertion, the Examiner’s Answer cites *In re Fulton*, 391 F.3d, 1195, 1201; 1141, 1146 (Fed. Cir. 2004) in holding that “the prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any

of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...” (Examiner’s Answer; page 14, line 20, through page 15, line 2).

Appellants respectfully submit that this assertion mischaracterizes and over generalizes the holding of *In re Fulton*.

First, Appellants note that *In re Fulton* concerns the issue of non-preferred and alternative described embodiments and their applicability as prior art. *In re Fulton* states that “[t]he prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...” (emphasis added; *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004); MPEP §2124(II)). *In re Fulton* also holds that a statement that a particular combination is not a preferred embodiment does not teach away absent clear discouragement of that combination (*In re Fulton*, 391 F.3d at 1199-1200).

In particular, Appellants respectfully submit that the holding of *In re Fulton* is not applicable to the use of Pranata. Appellants understand *In re Fulton* to pertain to a situation where prior art discloses and alternative or non-preferred embodiment, but does not specifically discourage the use of that embodiment. In contrast, Appellants respectfully submit that Pranata does not disclose alternative embodiments. Therefore, Appellants respectfully submit that the holding *In re Fulton* is not applicable to the use of Pranata.

In summary, Appellants respectfully maintain that Pranata teaches away from the claimed embodiments. Therefore, Appellants respectfully maintain that the basis for rejecting Claims 1-

5, 7-15, 17-35 and 37-44 under 35 U.S.C. § 103(a) is traversed and that, as a result, Claims 1-5, 7-15, 17-35 and 37-44 are in condition for allowance.

CONCLUSION

In view of the above remarks, Appellants continue to assert that pending Claims 1-5, 7-15, 17-35 and 37-44 are not rendered obvious by the asserted art as the rejections under 35 U.S.C. §103(a) do not satisfy the requirements of a *prima facie* case of obviousness, for reasons presented above and for reasons previously presented in the Appeal Brief.

Respectfully submitted,

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Dated: December 16, 2009

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